REMARKS

By this amendment and response, claims 1–10, 12, 13, and 15–19 have been amended, claim 11 has been cancelled, claim 14 has been rewritten in independent form, and claims 20 and 21 have been added. Accordingly, claims 1–10 and 12–21 are pending in the present application. The claim amendments are supported by the specification, claims, and drawings as originally filed. By way of example, support for the claim amendments and new claims can be found in paragraphs 9, 17, and 33 of the application. In addition, claim 2 has been amended to add the word "the" to improve the readability of the claim; a reason unrelated to the patentability of the claims. Accordingly, Applicants respectfully request reconsideration of the claims in view of the amendments and the following remarks.

1. Allowable Subject Matter

Claim 14 was objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form. Claim 14 has been rewritten in independent form to include all of the limitations of now cancelled claim 11. Accordingly, Applicants respectfully submit that claim 14 is in condition for allowance.

2. Rejections under 35 U.S.C. § 102(b)

Dependent claims 12, 13, and 15 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,125,361 ("*Bennett*"). Claims 12, 13, and 15 have been amended to depend from claim 14. For at least the same reason that claim 14 is now in condition for allowance, Applicants submit that claims 12, 13, and 15 are also in condition for allowance.

Independent claims 1 and 18 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Bennett*. Applicants respectfully traverse.

Bennett relates to a method for searching locally or remotely located transcripts, case evidence, or case law. Additionally, *Bennett* generally teaches editing searches by copying and pasting search terms into a search window. *See* column 11, lines 20–31; Figure 4a; Figure 8.

In contrast to the teachings of *Bennett*, claims 1 and 18 require either the step of returning or presenting search results to include at least one of: copying or pasting at least a portion of the search results into the first application; deleting or saving a portion of the search results; or displaying search results when a mouse cursor moves over selected search data. Where *Bennett* discloses performing steps of copying or pasting on search terms, claims 1 and 18 involve steps performed on search results. For at least this reason, Applicants respectfully submit that claims 1 and 18, as amended, are now in condition for allowance.

Dependent claims 2–10 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Bennett*. Claims 2–10 and new claim 20 depend from claim 1. For at least the same reason as that of claim 1, Applicants respectfully submit that claims 2–10 and 20 are also not anticipated by *Bennett*.

Independent claim 16 and dependent claim 17 have been rejected by the Examiner, under 35 U.S.C. § 102(b) as being anticipated by *Bennett*. Applicants respectfully traverse.

Bennett teaches running an application and having an attorney select an object in the transcript. *See* column 7, lines 60–65 ("[T]he attorney select[s] the potential mischaracterization objection"). After selecting the object, the attorney selects the search command. *See* column 7, lines 37–65. After the attorney selects the search command, the application formulates a search that requires very little or no typing by the attorney. *See* column 7, lines 53–65.

However, claim 16, as amended, requires, in contrast to the teachings of *Bennett*, performing a search without user input. In *Bennett*, the user inputs and initiates the search request, whereas claim 16 requires performing a search without user input. Accordingly, and for at least this reason, Applicants submit that claim 16 is in condition for allowance.

Claim 17 and new claim 21 depend from claim 16. For at least the same reason that claim 16 is now in condition for allowance, Applicants respectfully submit that claims 17 and 21 are also not anticipated by *Bennett*.

3.   Rejection under 35 U.S.C. § 103(a)

Claim 19 was rejected under 35 U.S.C. § 103(a) as being unpatentable over *Bennett* in view of U.S. Patent No. 6,125,361 ("*Chakrabarti*"). However, as will be shown, *Bennett* and *Chakrabarti*, fail to teach or suggest all of the limitations of claim 19, either alone or in combination. As such, Applicants respectfully traverse this rejection.

In general, *Chakrabarti* relates to a computer programmed to rank documents in response to a query, and generically recognizes searches performed through web browser search engines. *Bennett* does not disclose a browser application, but generally relates to a method for performing a search within case law, case evidence, or transcripts. More particularly, *Bennett* teaches performing a search by, in part, editing search terms by copying or pasting into a search window. *See* column 11, lines 20–31; Figure 4A; Figure 8.

Editing search terms by copying or pasting into a search window is in direct contrast to the presently claimed invention. In particular, as amended claim 19 recites, among other things, that "presenting the search results...comprises at least one of: copying at least a portion of the search results into the non-browsing application; pasting at least a portion of the search results

into the non-browsing application; deleting at least a portion of the search results; saving at least a portion of the search results; and displaying the search results when a user moves a mouse arrow over the previewed data in the non-browsing application." As noted above, while *Bennett* may disclose copying or pasting search terms, neither *Bennett* nor *Chakrabarti* teaches or suggests this approach to manipulating search results.

Applicants further note that in order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the Examiner is required to meet three criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143. As noted previously, *Bennett* discloses copying or pasting search terms, but neither *Bennett* nor *Chakrabarti* teach or suggest the approach of claim 19 to manipulating search results. Accordingly, the cited references fail to show every element of claim 19, and there can be no *prima facie* case of obviousness for the claim citing such limitations. Insofar as none of the cited references teach or suggest all the limitations of claim 19, Applicants respectfully submit that claim 19 is not obvious over *Bennett* in view of *Chakrabarti*, and the pending claim is in condition for allowance.

CONCLUSION

Applicants respectfully note that the above discussion should not be construed to constitute an exhaustive enumeration of the distinctions between the claims of the present application and the references cited by the Examiner. Instead, such distinctions are presented

solely by way of example. Applicants note further that the arguments presented herein have been made merely to clarify the claimed invention from elements purported by the Examiner to be disclosed by the cited prior art references. Such arguments should not, however, be construed as acquiescence on the part of the Applicants as to the purported teachings or prior art status of any of the cited references, nor as to the characterization of the cited references advanced by the Examiner. Accordingly, Applicants reserve the right to challenge the purported teaching and prior art status of any and all of the cited references at any appropriate time.

In view of the foregoing, Applicants respectfully request favorable reconsideration and allowance of the present claims. In the event the Examiner finds any remaining impediment to the prompt allowance of this application which could be clarified by a telephone interview, the Examiner is respectfully requested to contact the undersigned attorney.

Dated this _2_ day of July, 2004.

Respectfully submitted,

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